

**REMARKS**

Claims 19-29 are pending in the present application.

**Restriction of the claims**

The Examiner has required election of new claims 19-29 in the present application between:

Group I, claims 19-29, in part, wherein X is nitrogen; Y is oxygen, NH or imino; m is 0; n is 1, thus forming compounds having 3-fused rings; and

Group II, claims 19-29, in part, drawn to compounds not included in Group I, wherein X is CH; Y is O, NH, S, SO or SO<sub>2</sub>; and m and n form compounds having a 7-membered ring fused with a 6-membered ring or when n is 2 or 3, to form a compound having a 7- or 8-membered ring, which is fused with a 5-, 6- or 7-membered heterocycle having a Y variable.

Applicants traverse this rejection and withdrawal thereof is respectfully requested.

The Examiner asserts that the substituent in the generic formula (I) of Group I (e.g. X, Y, m, l and n) should be limited as discussed on page 2, Item 3 of the Office Action. Specifically, the Examiner asserts that the working examples only disclose 6:5:6 rings and that other combinations, such as 6:6:6, 6:7:6 or 6:7:7 tricyclic heterocycles are not supported by the specification.

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However, the Examiner is mistaken in this position. The Examiner's attention is directed to Example 8 of the specification, which discloses a tricyclic heterocycle that is a 6:6:6 combination and has the spiro frame structure of 2,4-diaza-7-oxa-spirobicyclo [4.4.0]decane-2-one. Thus, the specification discloses other than 6:5:6 combinations. This compound is described on page 207, line 17 to page 212, line 16, including the detailed description of the synthesis of the compound. As discussed in the specification, the compound of Example 8 can be synthesized using the general production methods of the invention that are described on page 93, line 23 to page 144, line 6 of the specification. Other ring combinations are similarly sufficiently disclosed from the general production methods, which include various ring combinations. As such, Applicants believe that the invention should not be limited as suggested by the Examiner.

In addition, the Applicants have tested several additional compounds having various sizes of spiro rings and heteroatoms that are encompassed by formula (I). The structures of the Compounds (1) to (7) are shown on "Attachment A". The Compounds (1) to (7) were synthesized using the methods described in the specification. The compounds (1) to (7) are also shown in the Table 1, below, wherein it is shown that the compounds have an inhibitory activity

within the range recited in the specification on page 165, lines 3-6.

**TABLE 1**

Compound	Ring Combination	Y	m	l	n	IC50 (nm) *
1	6:5:6	S	0	1	1	1.3
2	6:5:6	SO <sub>2</sub>	0	1	1	2.3
3	6:6:6	NH	1	1	1	3.5
4	6:6:6	S	1	1	1	25
5	6:5:7	NH	0	1	2	11
6	6:6:7	NH	1	1	2	884
7	6:5:7	O	1	0	2	96

\*Fxa inhibitory action was measured in accordance with the test method described on page 164 of the specification.

As noted above, not only 6:5:6 ring combinations, but various other ring combinations can also be produced using the methods described in the specification. In addition, compounds may be made wherein Y is S or SO<sub>2</sub>, or wherein m is 0 or 1; l is 0 or 1; and n is 1 or 2. The Fxa inhibitory action with the above-compounds is within the range of the inhibitory action described in the specification on page 165, lines 3-6.

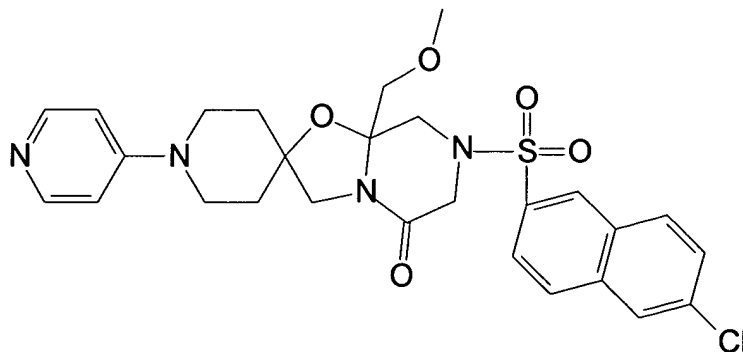
The data of Table 1 evidences that compounds exemplifying the full scope of Formula (I) can be synthesized using the methods described in the specification and such compounds have inhibitory activity for Fxa as described in the specification. Accordingly, Applicants assert that specification as originally filed contains sufficient support for the scope of the claimed invention and it is

not necessary to further limit the definitions recited for formula (I). As such, rejoinder and examination of the entire claimed subject matter is respectfully requested.

However, should the Examiner maintain the restriction of the claims, Applicants elect, with traverse, **Group I**.

**Election of species**

The Examiner has further required that Applicants elect a single species to begin searching. Applicants elect, with traverse, the following compound of Example 1:



Applicants further request that should no prior art be found regarding the elected compound, the remaining compounds of claim 20 be rejoined and searched.

**Additional Informalities Discussed in the Office Action**

*a) Sequence Listing*

The Examiner asserts that the specification fails to contain a computer readable disk for the Sequence Listing. Enclosed herewith in full compliance with 37 C.F.R. §§1.821-1.825 is a Sequence Listing to be inserted into the specification as indicated above. The Sequence Listing in no way introduces new matter into the specification. Also submitted herewith in full compliance with 37 C.F.R. §§1.821-1.825 is a disk copy of the Sequence Listing. The disk copy of the Sequence Listing, file "2003-12-22 1110-0306P.ST25.txt", is identical to the paper copy, except that it lacks formatting.

*b) PCT International application information*

The Examiner indicates that the correct PCT International Application No. has not been provided with the present application. Applicants have reviewed the transmittal letter submitted when the application was filed, the first paragraph of the specification and the Declaration & Power of Attorney. In all of these documents the PCT International application No. is correctly recited. As such, it is unclear to Applicants, where the Examiner believes there is an error. Clarification of this matter is respectfully requested.

c) Possible Double-patenting over U.S. App. No. 10/451,728

Applicant acknowledge the Examiner's indication that double patenting issues may be raised by the claims of co-pending application No. 10/451,728. However, this issue will be addressed at such time when any issues are formally raised by the Examiner.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact MaryAnne Armstrong (Reg. No. 40,069) at the telephone number of the undersigned below.

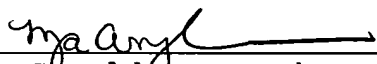
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

Appl. No. 10/026,606

required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17;  
particularly, extension of time fees.

Respectfully submitted,

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1110-0306P  
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Attachments: Sequence Listing  
Attachment A

## Attachment A ( Additional Compounds )

